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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Champagne et al.

Serial No.: 09/543,686

Filed: April 5, 2000

For: **ONLINE SYSTEM AND METHOD OF ORDERING
AND SPECIFYING CONSUMER PRODUCT
HAVING SPECIFIC CONFIGURATIONS**

Attorney Docket No.: FMC 1734 PUS / 81050056

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer mailed on March 11, 2005 for the above-identified patent application.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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Matthew M. Jakubowski
Name of Person Signing

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The Examiner's responses to the Applicant's Appeal Brief arguments improperly apply references in the context of the obviousness determination. In order to establish a *prima facie* case of obviousness the Examiner must meet three criteria:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 48, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 706.02. (Emphasis Added).

The Examiner stated:

... four periodicals were cited (herein referred to as Toyota) in order to demonstrate a well-defined public use of the claimed invention. The periodicals both sufficiently inform the Public of the invention and would allow a competitor to reasonably ascertain the invention. All of the cited periodicals were published less than one year prior to the filing date of the instant application.

(Examiner's Answer at 12.) (Emphasis Added).

These periodicals in combination with the *Henson* or *Green* references do not teach, disclose or suggest the claimed invention.

With respect to the periodicals, the Examiner has made no showing of a "well-defined public use" or even "knowledge" of the invention by Toyota. The language "known or used by another in this country" as recited in 102(a) means knowledge or use which is

accessible to the public. *Carella v. Starlight Archery*, 231 USPQ 644 (Fed. Cir. 1986); MPEP § 2132. The Examiner has not demonstrated “one well defined case” of public use. MPEP § 2133.03(a).

Further, periodicals that inform the public of a proposed future product release are insufficient to inform the public of an invention. The Examiner attempts to supplement the deficient teachings of the periodicals with knowledge gained through the Applicant’s disclosure, which is impermissible hindsight. Further, the *Henson* and *Green* references do not cure the deficient teachings of the periodicals. As such, the Examiner has failed to make the required *prima facie* showing of obviousness.

The Examiner concluded that his obviousness determination was not based upon improper hindsight:

in response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(Examiner’s Answer at 12.)

In making the obviousness determination, the Examiner fails to either rely on a reference or take official notice as to the teachings relied upon as prior art. Therefore, the Examiner’s conclusions are based on improper hindsight. The claimed invention is not taught through the combination of references cited by the Examiner. In rejecting Applicant’s claims

on obviousness grounds, the Examiner clearly used hindsight knowledge gained from the Applicant's disclosure.

Finally, the Examiner's argument that language in Applicant's claim does not positively recite an action step and therefore should not be given patentable weight is flawed. In making this determination, the Examiner stated that:

the cancelling language does not positively recite an action step, it only denotes a situation wherein a product may be cancelable if a relevant party involved in the transaction is not satisfied with the particular order. The limitation, "Cancelling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user." is a **conditional limitation and is given little patentable weight.**

(Examiner's Answer at 15.) (Emphasis Added).

The Examiner's analysis on this point is misguided. There is no section of the MPEP that prohibits the use of conditional limitations. Further, there is no case law supporting this proposition. As such, the Examiner cited neither. Moreover, Applicant asserts that this limitation does positively recite an action step of "cancelling the custom order," which should be given full weight with respect to patentability.

CONCLUSION

For the reasons set forth above and those explained in greater detail in Applicant's Appeal Brief, Applicant respectfully submit that all outstanding rejections are improper and should be reversed.

Applicant has made a genuine effort to respond to Examiner's objections and rejections in advancing the prosecution of this case. Applicant believes all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

No additional fee is believed to be due as the result of the filing of this paper. However, any additional fees or credits should be applied to Deposit Account 06-1510 (Ford Global Technologies, Inc.). A duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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